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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LISA SEACAT DELUCA and BRIAN GOODMAN

Appeal 2017-009680
Application 13/744,407¹
Technology Center 2400

Before NATHAN A. ENGELS, JAMES W. DEJMEK, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–15, 17–22, and 25–28. Claims 16, 23, and 24 have been canceled. Appeal Br. 27, 30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify International Business Machines Corporation as the real party in interest. Appeal Br. 1.

REPRESENTATIVE CLAIM

Claim 1, reproduced below, is representative of the claimed subject matter:

1. A method of informing a first entity of an activity of a second entity, the method comprising:

tracking, using a processor on a computer, whether any files related to the activity have been updated, to thereby automatically monitor the activity of the second entity during a period between a first time and a second time, the period between the first time and the second time being between a time of a first meeting and a time of a second meeting, the activity including a change made by the second entity that is associated with a task related to the first meeting, the tracking being performed by the processor, using a contextual collaborative tool being used by the first and second entities for accomplishing the task, the contextual collaborative tool interconnecting various application programs into a unified user interface to enhance collaboration among users;

calculating, using the processor, a level of progress toward a milestone related to the activity that is achieved due to the updating of the files that are tracked; and

informing the first entity of the activity of the second entity and the achieved level of progress, based on the tracking.

Appeal Br. 24 (Claims App'x).

THE REJECTION

Claims 1–15, 17–22, and 25–28 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–5.²

² The Final Rejection additionally states that claim 24 is rejected under 35 U.S.C. § 101. Final Act. 2–5. But, as noted above, claim 24 has been canceled. Appeal Br. 30. We treat this oversight by the Examiner as harmless error.

ANALYSIS

Appellants dispute the Examiner’s conclusion that claims 1–15, 17–22, and 25–28 are directed to patent-ineligible subject matter under 35 U.S.C. § 101. Appeal Br. 6–23; Reply Br. 1–11. Our analysis below focuses on whether the Examiner has properly applied the two-step test set forth by the Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

In *Alice*, the Supreme Court reiterated the framework set out in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012), for “distinguishing patents that claim . . . abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture or composition of matter), then the first step is to determine whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 134 S. Ct. at 2355. If so, the second step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 134 S. Ct. at 2355.

The Examiner concludes that although Appellants’ claimed invention broadly falls within the statutory categories of patent eligibility, the pending claims are directed to an abstract idea, without reciting significantly more. Final Act. 2–5. The Examiner characterizes claim 1 as directed to the abstract idea of “organizing human activities” because its “tracking,” “calculating,” and “informing” steps “describe the concept of informing an entity of tracked milestone progress between two meetings, which is similar to the abstract idea of concepts relating to interpersonal and intrapersonal

activities, such as managing relationships or transactions between people, social activities, and human behavior.” Final Act. 2–3.

In addition, the Examiner finds the “processor on a computer” and “contextual collaborative tool” recited in claim 1 do not amount to significantly more than the abstract idea. Final Act. 3–4. The Examiner explains, “[l]ooking at the limitations as an ordered combination also adds nothing that is not already present when looking at the elements taken individually.” Final Act. 4. The Examiner further explains “[t]here is no indication that the combination of the elements improves the functioning of a computer or improves any other technology. Their collective functions merely provide conventional computer implementation.” Final Act. 4. The Examiner also finds the additional elements recited in independent claims 9, 17, and 21 and dependent claims 2–8, 10–15, 18–20, 22, and 25–28 do not render any of these claims patent eligible. Final Act. 4–5; *see also* Ans. 5–6.

Analysis Under Step 1 of Alice

Appellants argue the pending claims are not directed to an abstract idea and that the Examiner’s characterization of the independent claims as “organizing human activities” is inaccurate. Appeal Br. 6–23; Reply Br. 1–11. Instead, Appellants assert the claims recites a specific application that solves a new problem and improves technologies in the marketplace. Appeal Br. 7, 9, 13–15, 21–22; Reply Br. 2, 9–11. More specifically, Appellants assert:

- a) “[T]he rejection currently of record proposes an abstract idea that is much broader than the claimed invention itself and . . . does not . . . reflect the literal language of the

- specific method steps defined in the claimed invention” (Appeal Br. 7 (emphasis omitted); Reply Br. 2);
- b) “[T]he claimed invention provides a solution to [a] newly recognized problem arising with computerized automatic tracking of progress between meetings such as scrum meetings used in managing projects” (Appeal Br. 9, *see also id.* at 17–18; Reply Br. 10); and
- c) Similar to the claims in *Bascom*,³ the claimed invention “describes both a specific application and an improvement to technologies in the marketplace” (Appeal Br. 14 (emphasis omitted), *see also id.* at 13–15, 21–22; Reply Br. 3, 9–11).

We disagree with Appellants and agree with the Examiner that the claims are directed to an abstract idea. Generally, claim 1 recites the steps of tracking whether certain activity data has been updated, calculating a level of progress towards a milestone achieved by the updated data, and informing an entity of the certain activity and the achieved level of progress based on the tracking. As further context, Appellants describe their invention as “making a meeting more efficient, and . . . provid[ing], prior to the meeting, detailed information to one or more participants of relevant events prior since any previous meeting.” Spec. 1:10–14.

Contrary to Appellants’ assertion that their invention solves a *new* problem, Appellants’ Specification describes the invention as automating a known manual process that was previously performed by a person who would “manually track[] everything they have done since the last meeting in a log,” “manually update the status of each task they are assigned in a timely

³ *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1351 (Fed. Cir. 2016).

fashion,” and “inform [others] of their progress on a task for a time period occurring from one meeting to the next.” Spec. 2:12–13, 21–22, 3:3–5. By automating this known manual process, “entities are not required to manually track everything they have done since a previous meeting or up to an initial meeting. As a result each of the entities can become more productive by focusing on accomplishing their tasks, rather than noting every little change they make.” Spec. 16:8–12.

Although claim 1 and Appellants’ Specification describe using a processor on a computer, files, and a contextual collaborative tool to perform Appellants’ method, we agree with the Examiner that the recited steps of claim 1 are directed to a method of organizing human activity (*see* Final Act. 2–5; Ans. 2–8), and we disagree with Appellants that the Examiner’s characterization of claim 1 is overly broad. To the contrary, the Examiner addresses each limitation of claim 1 and explains how, consistent with Appellants’ Specification, a human could perform each limitation. *See* Ans. 4–5.

Courts have similarly determined that various methods of organizing human activity fall “squarely within the realm of ‘abstract ideas.’” *Alice*, 134 S. Ct. at 2357 (discussing methods for risk hedging and intermediated settlement as non-limiting examples of organizing human activity). Among others, recent cases from the Federal Circuit also have “applied the ‘abstract idea’ exception to encompass inventions pertaining to methods of organizing human activity.” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (finding the claimed method of classifying and storing images in an organized manner was a well-established basic concept analogous to methods of organizing human

activity); see *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (finding the claim at issue was directed to the abstract idea of budgeting, which was “not meaningfully different from the ideas found to be abstract in other cases before the Supreme Court and our court involving methods of organizing human activity”).⁴

Similar to Appellants’ claims, the Federal Circuit has said that abstract ideas include collecting information, analyzing the information by using a mathematical algorithm, and displaying the results. *Elec. Pwr. Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1351–54 (Fed. Cir. 2016). The Federal Circuit also recently affirmed two District Court decisions finding abstract the ideas of booking, tracing, and tracking shipping containers. *Wireless Media Innovations, LLC v. Maher Terminals, LLC*, 100 F. Supp. 3d 405, 415 (D.N.J. 2015), *aff’d*, 636 F. App’x 1014 (Fed. Cir. 2016); *GT Nexus, Inc. v. Intrtra, Inc.*, No. C 11-02145-SBA, 2015 WL 6747142, at *9 (N.D. Cal. Nov. 5, 2015), *aff’d*, 669 F. App’x 562 (Fed. Cir. 2016).

We disagree with Appellants’ characterization of the claimed invention as a specific application and improvement to technologies in the marketplace, similar to the claims in *Bascom*. The claims in *Bascom* were directed to a technology-based solution of a specific way to filter content on the Internet that overcame existing problems with other Internet-filtering systems and improved the performance of the computer system itself. *Bascom*, 827 F.3d at 1351. By contrast, the instant claims are simply the

⁴ See also, e.g., *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (finding claims directed to collecting data, recognizing certain data within the collected data set, and storing the recognized data drawn to an abstract idea and noting that “humans have always performed these functions”).

generic automation of traditional process, implementing a known manual human activity on a computer for more efficient implementation of the abstract idea. *See Bascom*, 827 F.3d at 1351 (distinguishing the patent-eligible claims at issue from those in *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701, 193 (2015) because the invention in *OIP* was simply the generic automation of traditional price-optimization technique)). Merely “[u]sing a computer to accelerate an ineligible mental process does not make that process patent-eligible.” *Bancorp Services, LLC v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1279 (Fed. Cir. 2012); *see also CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1286 (Fed. Cir. 2013) (en banc) *aff’d*, 134 S. Ct. 2347 (“simply appending generic computer functionality to lend speed or efficiency to the performance of an otherwise abstract concept does not meaningfully limit claim scope for purposes of patent eligibility”).

We also disagree with Appellants’ assertion that the recited concepts of “scrum meetings” (*see* claims 27, 28) and “group effort” (*see* claims 9, 27, 28) indicate the claims solve a technological problem or add sufficient specificity to render the claims non-abstract. To the contrary, the Specification describes “scrum meetings” and “group effort” as known teamwork concepts irrespective of technology. *See* Spec. 1:17–2:6. Moreover, even if these limitations were novel or nonobvious and added a degree of particularity to their respective claims, the underlying concept merely encompasses the abstract idea of tracking data to determine if certain data has been updated, analyzing the updated data, and providing the results. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

In total, for the reasons stated above, we agree with the Examiner that claim 1 recites an abstract idea. For the same reasons, we also agree with the Examiner that independent claims 9, 17, and 21, which recite elements similar to claim 1, and claims 2–8, 10–15, 18–20, 22, and 25–28, which depend from independent claims 1, 17, or 21, are directed to an abstract idea.

Analysis Under Step 2 of Alice

We also agree with the Examiner that the claims do not recite significantly more than an abstract idea. In determining whether a claim recites significantly more than the abstract idea, “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 134 S. Ct. at 2357.

As identified by the Examiner, the claims recite additional elements—“‘processor on a computer,’ ‘files,’ the concept of updating files to keep track of progress of an activity, . . . ‘contextual collaborative tool’ . . .” and “‘memory device.’”⁵ Ans. 6. But, as the Examiner explains, these elements are no more than generic and known computer elements or functionalities. Ans. 5–6. “[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016) (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)).

⁵ Each of the pending claims recites “a processor on a computer” (or commensurately “a processor of a computer system”), “files,” the concept of updating files, and “contextual collaborative tool,” whereas claims 9–15 and 26–28 additionally recite a “memory device.”

In particular, Appellants assert the claims recite significantly more than an abstract idea because they “describe a specific method of tracking progress of tasks between meetings, using a contextual collaborative tool.” Appeal Br. 8 (emphasis omitted), *see also id.* at 10, 11; Reply Br. 2–10. But, as the Examiner explains, Appellants’ Specification describes “a contextual collaborative tool” as nothing more than well-known and conventional computer software ready for implementation. *See* Ans. 6 (citing Spec. 9:8–14 (“[A] ‘contextual collaborative tool’ is any of various tools that implement cooperative software that interconnects relevant applications such as word processors, instant messaging, calendars, groupware, etc., into a unified user interface to enhance collaboration. There are various such contextual collaborative tools currently available from . . . vend[o]rs.”)); *see also* Spec. 8:18–20 (“For example, any known contextual collaborative tool can be used. Some exemplary embodiments of the present invention use Rational Team Concert by IBM®.”). Accordingly, we also are unpersuaded by Appellants’ assertions in the Reply Brief that, because the claims use a “contextual collaborative tool,” they are distinguishable from the facts of *Intellectual Ventures I*⁶ and survive analysis under *Ariosa*.⁷ *See* Reply Br. 3–8.

Thus, Appellants have not presented, nor do we find, any persuasive evidence to support the assertion that the additional elements recited in independent claim 1 amount to significantly more than an abstract idea. For the same reasons, Appellants have not persuaded us that independent claims

⁶ *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332 (Fed. Cir. 2017).

⁷ *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015).

9, 17, and 21, and dependent claims 2–8, 10–15, 18–20, 22, and 25–28, which were not argued separately with particularity, recite significantly more than an abstract idea.

Appellants additionally argue “the rejection does not . . . evaluate any preemptive effects,” and “the claimed invention cannot reasonably be described as a . . . process . . . that could . . . preempt all possible methods to achieve automatic tracking of progress between meetings.” Appeal Br. 7 (emphasis omitted), 9, *see also id.* at 8, 10, 12–13, 19–20; Reply Br. 8–9. These arguments are unpersuasive. As the Examiner explains (*see* Ans. 7), “the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning*, 839 F.3d at 1098 (quoting *Ariosa*, 788 F.3d at 1379). Accordingly, even if Appellants’ claims do not preempt all possible methods to achieve automatic tracking of progress between meetings, this “do[es] not make them any less abstract.” *OIP*, 788 F.3d at 1362–63. Moreover, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

Appellants additionally argue “the Examiner’s withdrawal of the obviousness rejections and the lack of any 35 USC § 112 issues, are clear evidence that the claimed invention is not merely reciting an idea in the abstract.” Appeal Br. 16 (emphasis omitted), *see also id.* at 15, 22. We disagree. Subject-matter eligibility under 35 U.S.C. § 101 is a requirement separate from other patentability inquiries. *See Mayo*, 566 U.S. at 90 (recognizing that the § 101 inquiry and other patentability inquiries “might sometimes overlap,” but that “shift[ing] the patent-eligibility inquiry entirely

to these [other] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do”); *Diamond v. Diehr*, 450 U.S. 175, 190 (1981) (“The question . . . of whether a particular invention is novel is ‘wholly apart from whether the invention falls into a category of statutory subject matter.’”).

Accordingly, having considered the Examiner’s rejection in light of each of Appellants’ arguments and the evidence of record, we agree with the Examiner that claims 1–15, 17–22, and 25–28 are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

DECISION

We affirm the Examiner’s decision rejecting claims 1–15, 17–22, and 25–28 under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2016).

AFFIRMED